UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Paper No. 38

Application Number: 09/472,134
Filing Date: December 23, 1999
Appellant(s): GIROUARD ET AL.

Caroline D. Dennison, Jeffrey D. Karceski, and Paul Bowen
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed May 27, 2003.

(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) Status of Claims

The statement of the status of the claims contained in the brief is correct. Claims 61, 89, and 91 have been cancelled by the After Final Amendment of June 11, 2003 and amended claims 60 and 92 have been entered.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct. The After Final Amendments, filed June 11, 2003, have been entered.

(5) Summary of Invention

The summary of invention contained in the brief is correct.

(6) Issues

The appellant's statement of the issues in the brief is correct.

(7) Grouping of Claims

Appellant's brief includes a statement that claims s 1-49, 55, 57, 58, 60, 64-68, 73, 77-88, 90, and 92 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

20274681	Kitamura t al.	11/1990

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-49, 55, 57-60, 64-68, 73, 76-88, 90, and 92 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Applicant fails to show an operative embodiment of the invention. The only drawings of applicant's invention are Figures 2 and 3, which show the snowmobile with a rider in the prior art position and in the position he would assume if riding on applicant's snowmobile. The main difference between the two snowmobiles (the prior art one and that of the applicants) is the position of the handlebars. However, the positioning of the handlebars in Figures 2 and 3 would not allow any significant steering of the vehicle. Therefore, applicant's invention, as disclosed, is inoperative.

The embodiment of figures 2 and 3 is the only disclosed embodiment. By showing the prior art configuration and that of applicant's invention superimposed on each other, applicant appears to be directing the reader to make only the changes shown and, otherwise, leave the standard snowmobile structure intact. However, following this instruction would lead a skilled artisan to construct a vehicle with a

steering member (handlebar) that buts up against the windshield and is incapable of any significant steering operation.

To accomplish applicant's ultimate objective of a snowmobile with a center of gravity, seat position, foot position, and steering position that have particular relative positions, every element of the snowmobile must be taken into consideration. Applicant has not disclosed the many required elements of a working snowmobile. Basically applicant relies on an existing snowmobile configuration, with certain specific modifications. Most significant of these changes is the steering member position. However, the examiner maintains that this specific change which applicant directs the reader to make renders the vehicle inoperative, and therefore, applicant has failed to provide an enabling disclosure which would allow one of ordinary skill in the art to make and use the invention without undue or unreasonable experimentation (a complete redesign of the vehicle).

Claims 60, 73, 85, 88, 89, and 92 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Recitation of a "tunnel" and its relationship to other structure on the vehicle is not supported by the original disclosure. Also, the position of the toeholds in a vertical plane above the rider's toe is new matter, not specifically disclosed or shown in the original drawings. The original drawings showed a vertical wall at the forward end of the footboards, which could be considered applicant's toeholds. Applicant's detailed

disclosure merely referred to toe holds, without any structural detail. Applicant may not rely on the amended drawing to show this feature because that drawing change was only approved to schematically show a toe hold, not any particular location of that toe hold.

The amendment filed May 22, 2002 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: reference to a "tunnel" is not supported by the original disclosure and a toe hold lying in a vertical plane above the rider's toe.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claims 1-49, 55, 57, 57, 64-68, 77-84, 87, and 90 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In each of the claims, applicant recites a "standard rider" and/or a "standard position" of a standard rider. However, the examiner maintains that a rider, a human being, cannot be standardized. Also, even if the rider could be standardized, the position of the rider on the cycle depends on more than simply the dimensions of the rider. The stiffness of the joints, the comfortable posture, the energy level of the rider, and simple preferences of the rider factor into their positioning on the cycle. Therefore, applicant's recitation of the vehicle based on the position of the standard rider is believed to be indefinite because it lacks a reasonable degree of certainty with respect

to the structural features it is meant to describe. It forces the potential infringer to design and build his vehicle without knowing if it will infringe until tested using a standard rider.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 73 is rejected under 35 U.S.C. 102(b) as being anticipated by JA 2-274,681.

JA 2-274,681 shows a snowmobile with sideboards for a rider's feet, which extend along the side of the body and end at the front cowling. The sideboards are angled at approximately 6 degrees from horizontal. The forward upwardly extending wall of the cowling provides a toe hold which prevents the rider's foot from sliding forward. Figures 1, 3, and 9, of JA 2-274,681 also show upright walls which extend directly vertically above a recessed area in which a rider may wedge his toe to releasably hold the toe in place.

(11) Response to Argument

Prior art Rejection of claim 73

Appellant argues that the Japanese reference 2-274,681 fails to teach sideboards that are angled between –5 and –10 degrees from horizontal and toeholds

that allow a rider to secure himself to the snowmobile or that are positioned above the sideboards.

First appellant argues that the reference simply fails to teach sideboards at an angle of –5 to –10 degrees because the reference is silent as to the angle of the footrest. The examiner agrees that the text of the reference does not refer to a specific angle of the footboards, however, the drawings specifically show it. The drawings, as part of the disclosure, cannot be ignored nor can features they specifically show. The sideboards of JA 2-274,681 are shown at a forwardly sloped angle of approximately 6 degrees. This falls squarely within the range claimed by appellant.

Appellant argues that the prior art may not be relied on for measurements from the drawings if there is no indication that the drawings are to scale. However, the footboard measurement does not rely on the drawings being to scale. The snowmobile could be for a child or for a giant. That is irrelevant to the angular measurement of the angle of the sideboard shown. Also, the examiner is not modifying another teaching to reach the claimed combination. The examiner is simply looking at the teaching provided by the reference drawings and noting that it specifically shows the claimed angling of the sideboards.

Appellant also argues that JP '681 shows not disclose left and right toeholds for allowing the rider to releasably secure himself to the snowmobile. Appellant's dislcosure has left it to the reader's imagination what is encompassed by toeholds, since not a single embodiment is described or shown in appellant's original disclosure. A toe-hold could be a clip, strap, buckle, ledge or simply a wall or protrusion that helps

to keep the rider's toe in place. The only reference in appellant's original disclosure is on page 10, lines 6-7 and original claims 72-75, where appellant indicates that "[p]referably, toeholds are disposed above these forward portion [of the sideboards] and permit the rider to releasably secure himself to the vehicle". Appellant did not refer to any element in the original drawings as showing the toe-hold structure. Original Figures 5-18, show a vertical wall at 144 which could to provide a schematic depiction of basic toe-hold structures that are above (vertically higher than, but not necessarily overhanging) the forward portions of the sideboards. The disclosure does not, however, show or describe a toe-hold that is in a vertical plane extending through the rider's toe.

JA '681 shows sideboards 9. It also shows a portion 10a, 10b, which overhangs (juts backwardly, as seen in Figures 1 and 9), in a vertical plane above a recessed portion of the body into which the rider's toes would be nested for securement. This rearwardly jutting portion can serve as a toehold for a rider's when the rider needs additional restraint, such as when tranversing irregular terrain. The claims do not require that the toes are positioned below the toeholds when the rider's feet are on the sideboards. Therefor, all of the features of claim 73 are believed to be taught by JA '681, as broadly and functionally recited.

Rejection of claims 1-49, 55, 57-60, 64-68, 73, 77-90, and 92, based on 35, U.S.C. 112, First Paragraph, lack of enablement

On page 8, footnote 3, appellant indicates that a Supervisor and Quality Assurance Specialist met, at appellant's request, to discuss issues with respect to this

application. Given that there is no record of this meeting in the present case and the examiner was not in attendance, the statement is believed to be improper, irrelevant and misleading, and it would be inappropriate for the examiner to discuss it further.

Appellant argues that any rejection based on a conflict between the windshield structure and that of the steering device should only apply to claims reciting both the windshield and the steering device. The examiner disagrees. The disclosure includes a windshield which prevents operation of the steering device, therefore, any claim reciting either the steering device or the windshield (which includes all of the claims presently on appeal) describes an inoperative invention. Also, when the steering device is inoperable, the entire vehicle is inoperable for the purpose for which it was designed and so all claims based on that disclosure should be rejected on that basis. The positioning of the steering member is absolutely critical to applicant's invention. Moving the steering position forward allows the engine to be positioned below and behind the steering member, which positions the center of gravity relatively forward and closer to the rider's center of gravity. Most of the other claimed features, particularly the recitations of the center of gravity of the snowmobile and the rider, are a result of the particular positioning of the steering member and engine. If applicant's disclosure of the steering member position is erroneous, a skilled artisan reading applicant's disclosure has very little guidance in making the claimed invention. In fact, an artisan would essentially have to start from scratch in constructing an operative embodiment. The examiner maintains that that would require undue experimentation and, therefore, applicant's overall disclosure is not enabling of the claimed subject matter. It is also

unclear how a skilled artisan would approach making the claimed invention with such inconsistent teachings.

Appellant explains that the test of whether a disclosure is enabling is whether undue or unreasonable experimentation is needed to practice the invention. Appellant argues that undue experimentation is not required to construct the present invention because a snowmobile designer would recognize that the windshield could be slightly more spaced from the steering device or configured to turn with the steering device. However, appellant has not disclosed such structure. While the examiner agrees that, generally, a skilled snowmobile builder could and would build a snowmobile with an operational steering device, it is not apparent that a skilled artisan could build an operational snowmoble based on or which conforms to the teachings of appellant's disclosure. According to appellant's disclosure, the positioning of the steering device is the feature which allows the shifting of weight forward and the advantageous placement for the rider on the vehicle. That disclosure also indicates that the placement of the windshield relative to the steering device is important to achieving the positioning of the rider's head in the laminar flow portion of the air stream. If that disclosure is flawed then it is not clear if the windshield poses the design problem or if it is the steering device position and/or angle that must be modified. Given the uncertainty as to how the appellant's device would have to be modified to be operational, the examiner maintains that the disclosure is not enabled.

Appellant criticizes the examiner for seizing on one portion of the disclosure to determine the lack of enablement. However, the positioning of the steering device is

the most important feature of appellant's disclose. It is one of the few concrete structural features that is described and it is an element which drives the positioning of the other elements of the vehicle. Therefore, the examiner maintains that the rejection based on 35 USC 112, first paragraph, lack of enablement is well founded.

Appellant points to the declaration of Robert Handfield, filed July 9, 2002, paragraphs 46-48, for support that the original disclosure is enabling. The declaration indicates that one of ordinary skill in the art would not have added a windshield in a position which would destroy the ability to steer. It also points to descriptions on page 13, line 20 to page 14, line 6 for additional disclosure of the positioning of the windshield. However, these statements are not convincing. Applicant's detailed disclosure indicates that the position of the steering member is critical to the invention. It does not suggest adding a windshield that interferes with the steering member, but rather seems to teach keeping the windshield in the same position as prior art snowmobiles and moving the steering member to an extreme forward position. The portions of the specification applicant points to further reinforce that the positioning of the steering member relative to the windshield is intentional. The disclosure on pages 13 and 14 of where the windshield is positioned relative to the seating position is entirely consistent with figures 2 and 3. Therefore, the erroneous positioning of the steering member and/or the windshield appears to be not simply a drafting error, but rather a defect in applicant's entire disclosure.

Applicant indicates that another type of steering member in the position shown would be operational. However, another steering member is not shown. A vehicular

steering wheel would not fit in the space shown if its steering shaft were angled and positioned as disclosed, and it is not seen how an aircraft-type yoke would be adapted for a snowmobile, which has a very different drive and control system. Also, certain of applicant's claims (claim 61, for example which recites relative positions of the steering device, drive axle and center of gravity, which are all closely spaced as it is) rely on the steering member being a handlebar and extending no farther back than the position shown.

Applicant indicates that the windshield could be removed, as in Figure 4, or could move with the steering member. However, figure 4 is not described as being an embodiment of the invention with the windshield removed. Also, even if the windshield were removed, Figure 4 depicts entirely unrealistic handlebar positions. In operation a rider would never be able to move the steering member through 90 degrees and, even if the steering member could move to that extent, skis with the type of suspension shown could turn through such an extreme angle. Therefore, figure 4 is not believed to depict an operative embodiment of appellant's invention.

The declaration also points to the schematic drawing on page two of exhibit C. However, that schematic drawing, unlike the one in the present application, shows the steering member in a position which would allow significant steering and it shows a very different body design. The windshield in that figure is shown with a much greater spacing between the steering member and the windshield than shown in applicant's figures 2 and 3. The embodiment of that exhibit does not resemble the embodiment of the present disclosure and is clearly not the same vehicle. Again, the examiner agrees

that a skilled artisan would be able to make a snowmobile that is steerable. However, the examiner maintains that the disclosure does not give adequate information as to how a skilled artisan would make an operable snowmobile conforming to the claimed features. Therefore, appellant's arguments and exhibits are not convincing and the rejection based on 35 USC 112, first paragraph is being maintained.

Request to Enter Drawing Correction

On pages 12-13, appellant asks the Board of Patent Appeals and Interferences to approve drawing corrections. Such a decision is a petitionable matter and not to be decided by the Board. Since appellant has not presented a petition requesting the entry of drawings, that request will not be discussed further in this Examiner's Answer.

Rejection of claims 60, 73, 85, 88. and 89, in accordance with 35 USC 112, First Paragraph for Failing to Describe Toeholds and a Tunnel, as Claimed

Appellant argues that Figures 5-18 show and describe the claimed tunnel. Appellant admits that the term "tunnel" does not appear in the original disclosure. Appellant refers to the Canadian priority document, which is incorporated by reference into the present application for support for that structure. However, neither the priority document nor the present application fully supports the claim language and there is no instruction in either disclosure to combine their teachings. The priority document shows and describes a snowmobile embodiment that shares very few features with that of the present invention. The Canadian patent shows a very different body design, with considerable structure which is not consistent with the embodiment disclosed in the present application. The Canadian patent alone does not support the present claim,

including the angle of the steering device or any specifics with respect to the position of the center of gravity of the rider or the snowmobile. Even if the entire text and drawings of the priority document were incorporated into the present application, that would not result in a disclosure that would fully support the present claims. Rather, it would describe multiple mutually exclusive embodiments, none of which, corresponds to the embodiment appellant is now attempting to claim.

The examiner agrees that the Canadian priority document shows a snowmobile embodiment having a tunnel. The examiner disagrees, however, that a skilled artisan would have attributed the features of the embodiment shown in Figure 9 of the Canadian document to the embodiment described in the present application, even given that the priority document was incorporated by reference. Appellant's proposed changes to Figures 2 and 3 show how dramatically the structure of the priority document differs from that of the embodiment described in the present application. Therefore, the examiner maintains that the original disclosure taught that combination.

Without attributing the teachings of the Canadian priority document to the embodiment disclosed in the present application, the examiner cannot find support for a recitation of a tunnel. As appellant discusses, a tunnel is a specific unibody frame structure known in the art. The only structure appellant can point to in the present disclosure as teaching this structure is a schematic depiction of "frame 114", which is shown as a simple horizontal line in Figures 5-18. By amending the specification to include the term "tunnel", appellant is adding substantial structure (including the unibody construction with a U-shaped member positioned directly below the seat, etc.) that was

not even hinted at in the original disclosure. Therefore, the new matter rejection is being maintained.

Appellant argues that the recitation of toeholds "above the rider's toe in a vertical plane" are also fully supported by the original disclosure. The examiner disagrees. While the examiner agrees that the original disclosure described the toeholds as being "above" (at a higher elevation than) the sideboards, it did not describe or show them to be in the vertical plane over the rider's toes. As discussed above, the walls that extend up from the front of the sideboards could have been what was meant by appellant's original disclosure, while the vertical alignment of the toeholds with the rider's toes describes an additional structural relationship that is not supported by that original disclosure.

Rejection based on 35 USC 112, Second Paragraph

Applicant argues that it is unreasonable for the examiner to preclude claim language which relies on the definition of a rider and how/where that rider would sit on applicant's vehicle. The examiner disagrees. Applicant has provided examples of claim language relating to a rider's dimensions that were found to be permissible, where the rider's dimensions were specified. However, even if it is permissible for a court to validate claim structure relating to a single simple dimension of a user, like his height or the length of his thigh (where that dimension is provided in the disclosure) that is not what applicant is doing in the present case. Applicant's claims are not so simple or straightforward. A potential infringer, to determine infringement of most of applicant's claims, would have to design and build a snowmobile and then place a standard sized

person on it, in the "standard position", as best can be made out from applicant's disclosure. The examiner believes this would involve undue experimentation and uncertainty for the potential infringer.

Applicant states that the scope of each claim can be determined with an incredible amount of detail with respect to the standard rider. However, the examiner does not believe the features of applicant's snowmobile can be extrapolated from applicant's disclosure and drawings (particularly in view of the problems with the drawings, indicated above) with any degree of certainty. The details disclosed are not of the vehicle but rather are based on a theoretical position that a particular rider would assume. Again, appellant's recitation of the vehicle, based on the position of the "standard" rider and in a "standard" position on the vehicle, is believed to be indefinite because it lacks a reasonable degree of certainty with respect to the structural features of the vehicle it is meant to describe.

Therefore, the rejection, based on 35 USC 112, second paragraph, is being maintained.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,
9/8/03
Anne Marie M Boehler
Primary Examiner
Art Unit 3611

amb
September 8, 2003

Conferees
A.M.B.
A.L.
L.M.

PILLSBURY WINTHROP, LLP
P.O. BOX 10500
MCLEAN, VA 22102